

REMARKS

The present paper is filed in response to the Official Action dated February 11, 2004, a Final Action, and to a subsequent interview conducted April 8, 2004 with respect thereto.

The courtesies extended by the Examiner during the aforementioned interview are noted with appreciation, as is the Examiner's care and detailed attention exercised in connection with the application.

In view of the requirement set forth in form PTOL-413 summarizing the interview, applicant provides the following Statement of the Substance of the Interview.

The Examiner's summary of the substance of the interview is substantially correct. It is noted that, during the interview the Examiner clarified his position with respect to the Declaration, particularly with respect to the assertion (at pages 9-11 of the Action) that the second error identified in the Declaration "is not correctable error". The Examiner noted that this statement relates to the description beginning at the fourth full paragraph of page 3 of the Declaration. The Examiner further noted that it is not necessary to delete this portion of the Declaration when a Supplemental Declaration is filed to address any additional corrections.

An appropriate Supplemental Declaration is accordingly filed herewith, referring to the drawings and to any other errors corrected during prosecution.

Additionally, during the interview it was noted that the invention realizes an object identified at col. 4, lines 53-57 of the reissue application and that claim 133, as well as proposed amendments thereto, attain the same objective without the limitations added to claim 120 during prosecution of the issued patent as such limitations were not, and are not, required for patentability of claim 133.

The Examiner clarified that, to the extent that the limitations in claim 133 (or the proposed amendment thereto) do not include a recitation related to the “one wavelength” limitation, the claims would be treated as seeking to recapture surrendered subject matter and would be rejected. The Examiner further noted that the claims should include recitations of some features related to the list of five elements bridging pages 5-6 of the pending Action.

At this point, applicants’ attorney presented an analysis relating to the decision of the Board of Patent Appeals and Interferences in *Ex Parte Eggert* (cited in the pending Action), noting applicability of this decision to the facts of the claims presented in the present reissue application, and the difference between the more generalized decisions of the Court of Appeals for the Federal Circuit cited by the Examiner and the specific holding of the Board.

However, the Examiner made it clear that, at the present level of prosecution, the interpretation given to the cited case law would continue, and that the *Eggert* decision would not be followed as controlling precedent, notwithstanding applicants’ analysis. The Examiner stated that the pending claims

would thus continue to be rejected, whether or not such rejection might ultimately be reviewed by the same body which issued the *Eggert* decision.

Accordingly, to expedite allowance and reissue in the event the Examiner continues to take the position set forth in the Action, the present amendment adds to claims 133, 154 and 157 the five features noted by the Examiner at pages 5-6 of the Action.

In order to clarify the nature of the amendment, as well as to demonstrate the support therefore identified at page 7 herein, the amended claims are presented herein in a different format, wherein the claims are marked to show (by underlining) the nature of the amendment from the previously submitted version of these claims: Moreover, in the following version the claims are annotated with bold faced italicized parenthetical identifiers (1) to (5), following bold faced recitations which correspond sequentially to each of the five features identified by the Examiner at pages 5-6 of the Office Action, as illustrated in similarly annotated claim 11 of the issued patent, which follows claim 157 in the following listing.

1 133. (Currently Amended) A compound objective lens, comprising a region to
2 produce a focal point on an information plane through a layer, wherein
3 the region of the lens is divided into a plurality of regions including at least both
4 of a first region and a second region by dividing the region of the lens depending on
5 differences in a distance from an optical axis of the lens,
6 the first region being located at a position farther from the optical axis than a
7 position of the second region,
8 the second region being optimized so that the lens has a numerical aperture NA2
9 to produce a focal point through a second layer on an information plane placed at a
10 distance T2 from a surface of the second layer, and
11 both of the first region and the second region being optimized so that the lens has
12 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a

13 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from
14 the surface of the first layer,
15 wherein the compound objective lens has a first convex surface and a second
16 convex surface opposite to each other (3), for receiving a beam of incident light of one
17 particular wavelength (5) passing through the optical axis at the first convex surface,
18 and the compound objective lens refracts the beam of incident light and emits a beam of
19 refracted light from the second convex surface, and
20 the region of the lens receives the beam of incident light not yet refracted by the
21 lens (1), and generates from the incident light a plurality of beams of divided light
22 (2), and generates a plurality of focal points which are placed on the optical axis on a
23 side facing the second convex surface (4).

1 136 (Currently amended). A compound objective lens according to claim 134, in
2 which the optical relief is provided on a side of the compound objective lens opposite to
3 [the] an optical disk.

1 154. (Currently Amended) An optical head apparatus for performing at least one
2 of recording and reproduction of pieces of information on and from an optical disk placed
3 to face the optical head apparatus, comprising
4 (i) an optical source for radiating a light beam; and
5 (ii) a compound objective lens receiving the light beam and comprising a region
6 to produce a focal point on an information plane through a layer, wherein
7 the region of the lens is divided into a plurality of regions including at least both
8 of a first region and a second region by dividing the region of the lens depending on
9 differences in a distance from an optical axis of the lens,
10 the first region being located at a position farther from the optical axis than a
11 position of the second region,
12 the second region being optimized so that the lens has a numerical aperture NA2
13 to produce a focal point through a second layer on an information plane placed at a
14 distance T2 from [the] a surface of the second layer, and
15 both of the first region and the second region being optimized so that the lens has
16 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a
17 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from
18 the surface of the first layer,
19 wherein the compound objective lens has a first convex surface and a second
20 convex surface opposite to each other (3), for receiving a beam of incident light of one
21 particular wavelength (5) passing through the optical axis at the first convex surface,
22 and the compound objective lens refracts the beam of incident light and emits a beam of
23 refracted light from the second convex surface, and
24 the region of the lens receives the beam of incident light not yet refracted by the
25 lens (1), and generates from the incident light a plurality of beams of divided light
26 (2), and generates a plurality of focal points which are placed on the optical axis on a
27 side facing the second convex surface (4).

1 157. (Currently Amended) An optical disk apparatus, comprising;

(1) an optical head apparatus for performing at least one of recording and reproduction of pieces of information on and from an optical disk placed to face the optical head apparatus, comprising:

- (i) an optical source for radiating a light beam; and
- (ii) a compound objective lens receiving the light beam and comprising:
 - a region to produce a focal point on an information plane through a layer, wherein the region of the lens is divided into a plurality of regions including at least both of a first region and a second region by dividing the region of the lens depending on differences in a distance from an optical axis of the lens,
 - the first region being located at a position farther from the optical axis than a position of the second region,
 - the second region being optimized so that the lens has a numerical aperture NA2 to produce a focal point through a second layer on an information plane placed at a distance T2 from [the] a surface of the second layer, and
 - both of the first region and the second region being optimized so that the lens has a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from the surface of the first layer, and
 - wherein the compound objective lens has a first convex surface and a second convex surface opposite to each other (3), for receiving a beam of incident light of one particular wavelength (5) passing through the optical axis at the first convex surface, and the compound objective lens refracts the beam of incident light and emits a beam of refracted light from the second convex surface, and
 - the region of the lens receives the beam of incident light not yet refracted by the lens (1), and generates from the incident light a plurality of beams of divided light (2), and generates a plurality of focal points which are placed on the optical axis on a side facing the second convex surface (4);

- (2) a moving apparatus for moving the optical head apparatus; and
- (3) a rotating apparatus for rotating the optical disk.

Issued Claim 11. A compound objective lens, comprising:

lens means, having a first convex surface and a second convex surface opposite to each other (3), for receiving a beam of incident light of one particular wavelength (5) passing through an optical axis at the first convex surface refracting the beam of incident light and emitting a beam of refracted light from the second convex surface; and

plural focal point generating means for receiving the beam of the incident light not yet refracted by the lens means (1), generating from the beam of incident light a plurality of beams of divided light including a first beam of divided light and a second beam of divided light (2), converging the beams of divided light at a plurality of focal points which are placed on the optical axis on a side facing the second convex surface (4) of the lens means on condition that the first beam of divided light transmits through a first substrate and is converged on an information recording plane placed at a first distance T1 from a surface of the first substrate at a diffraction limit and that the second beam of divided light transmits through a second substrate and is converged on an information recording plane placed at a second distance T2 (T1≠T2) from a surface of the second substrate at a diffraction limit

in which the plural focal point generating means is a hologram generating from the incident light as the beams of divided light a plurality of beams of diffracted light having different diffraction orders

in which a positional relationship between the lens means and hologram is fixed in which the hologram is formed on a lens surface of the lens means.

Traverse and Request for Reconsideration

In the pending Action, and again at the interview of April 8, 2004, the Examiner attempts to dismiss the holding in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003), which is factually applicable to the present application. Instead, the Examiner relies on the earlier decisions of the Federal Circuit in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, (Fed. Cir. 2001) and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161, (Fed. Cir. 1997), neither of which is related to the present situation.

It is first noted that a fundamental issue in the present reissue application is whether the applicant is impermissibly attempting to recapture surrendered subject matter or whether applicant is attempting to correct an error during prosecution, which resulted in applying an overly narrowing limitation to the claim while failing to recognize that a less severe limitation, or an alternate limitation, would have sufficed to overcome the prior art rejection.

More particularly, in the present situation the Examiner has admitted that the various claims rejected under the so-called recapture rule distinguish over the prior art. That is, the Examiner has effectively stated that the claims are narrower than claims rejected during prosecution of the issued patent, in an aspect related to the rejection (rejections under 35 USC 102 or 103 are rejections over prior art;

claims which distinguish over the prior art are thus narrower in an aspect related to such a rejection).

Therefore, while the claims are broader than the issued claims in some aspect (indeed, the present application is a broadening reissue application), the claims are nonetheless narrower in an aspect which is *not* “completely unrelated to the rejection” applied during prosecution of the issued patent.

As noted during the interview of April 8, 2004, this is precisely the situation which the Board considered in *Eggert* and which is differentiated from the facts under *Clement* and *Pannu*.

That is, the narrowed limitations added by applicants to the presented reissue claims admittedly distinguish over the prior art and are therefore germane to a prior art rejection. As such, the reissue claims are “narrower in an aspect germane to the prior art rejection”, thus differing from the question raised in *Clement*, whether the narrower aspect is “completely unrelated to the rejection.” The Examiner is courteously reminded that the *Clement* holding *does not refer to* relation of the narrower aspect to “*subject matter*”. Instead, (as quoted by the *Eggert* board at pp. 26-7 and 43) in identifying a situation in which recapture does not bar a claim, the *Clement* Court stated that if the new claim is “as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim.”

Under *Clement*, the relation of the new claim limitation must be to the previous rejection, not to the previously surrendered, or previously added, subject matter.

Thus, the broadened and narrowed aspects are merely identified as such with respect to a prior art rejection. That is, if the reissue claim is narrowed in “another aspect completely unrelated to the rejection” the claim is barred for an attempted recapture. However, if the narrowed addition is related to “the rejection” (i.e., to a prior art rejection), the claim does not seek recapture. This clearly differs from the interpretation provided in the Official Action, which asserts that the narrowed subject matter must be related to the surrendered subject matter.

In other words, the *Clement* decision does not state, address or require anything of the added limitation relative to the “subject matter” of the originally added limitation, but only that the presently added limitation be narrower in an aspect which is not completely unrelated to the (original) rejection, as is clear from the court’s earlier definition of the added breadth of the reissue claim as being “in an aspect germane to a prior art rejection”, and not “germane to a feature added to overcome a prior art rejection.”

It should thus be clear that the Official Action is not following either the *Eggert* or the *Clement* decision, but is instead interjecting its own narrower interpretation of the same, in barring a claim which adds a limitation that is quite clearly “related to the rejection” -- i.e., fully addresses the prior art rejection by narrowing the canceled claim to differentiate from the prior art.

Moreover, the Examiner’s admission that the presented claims are distinguished over the prior art (and allowable but for alleged recapture) shows the claims to have been materially narrowed from the claims originally presented (and surrendered) during prosecution of the issued patent. This distinguishes the present situation from that considered in the decisions relied upon in the Action.

The foregoing is further illustrated by the following, wherein references to page numbers correspond to the pagination in the pdf file of the *Eggert* decision provided on the USPTO website

The paragraph bridging pages 3-4 of the Action essentially repeats the argument raised in *Eggert* by the examiner, found at the last line of page 13 through line 3 of page 14 and at the last 6 lines of page 19 of the *Eggert* decision. It is noted that precisely such an argument was rejected by the *Eggert* board. Moreover, at page 14, lines 4-8 of the *Eggert* decision, the Board also rejected the argument that substitution in the reissue application of one limitation for another is not correctable error under 35 USC 251.

Fundamental to the *Eggert* decision is the definition provided by the Board for identifying what was the subject matter “previously surrendered”. *Eggert* holds that what was surrendered was the subject of the *cancelled* claim, i.e., a claim pending *prior* to amendment, rather than the *difference* between that claim and a narrowed scope of the issued claim subsequent to an amendment. Such an approach reasonably permits correction of an erroneous, unduly narrowing, limitation which is added during prosecution when a lesser, or different, degree of narrowing would have sufficed.

At page 5 of the Action, following consideration of the prosecution history of the patented file, the Examiner argues that “since Applicants argued the specific limitations, the underlined passages [identifying the limitations added to the claims] indeed represent subject matter that was surrendered to obtain a patent.” A

similar position is taken at lines 6-12 of page 6 of the Action. However, such an argument is *erroneous* under the *Eggert* decision, as it clearly corresponds to the per se rule taken by the examiner, and reversed by the Board, in *Eggert* (e.g., page 14, lines 10-12).

In fact, under *Eggert*, the Board quotes the *Clement* court (at page 25) and determines the surrendered subject matter by comparing the reissue claims with the canceled claim [not with the issued amended claim] and states that, “if the scope of the reissue claim is the same as or broader than that of the *canceled* claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable.”

Thus, any “surrender” taking place whether by argument, amendment or cancellation, refers to the scope of the cancelled or amended claim, prior to cancellation or amendment, and not to the limitations added to (or argued for) the claim.

Therefore, the statement at lines 11-12 of page 6 of the Action, that “Applicants surrendered *at least* these broader aspects”, is clearly at odds with the Board’s position. In fact, a proper consideration as to the “surrendered” subject matter would state that “Applicants surrendered at most these broader aspects” since it is the unamended recitation, rather than the amendatory language (or argued features) which are surrendered.

It is accordingly respectfully submitted that the pending claims present a correctable error, and do not seek to recapture any surrendered subject matter.

For these reasons, applicants courteously traverse the rejection in the pending Official Action, and request reconsideration of the same. The Examiner is respectfully requested to contact applicants' undersigned attorney upon such reconsideration in order to expedite allowance of the pending claims.

In the event that the Examiner is not persuaded by the foregoing, however, the present amendment adds features of the invention which are identified by the Examiner in the pending Official Action, thus overcoming the recapture argument set forth in the Action.

Additionally, claim 136 is amended to overcome the Examiner's objection thereto set forth at page 2 of the Action.

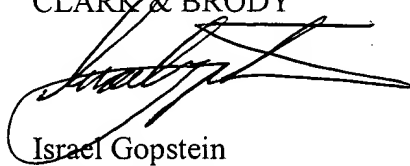
The present amendment thus eliminates issues for appeal, does not raise new issues, and is fully responsive to the objections, rejections and arguments set forth in the pending Official Action. Accordingly, entry after Final Action is appropriate and the same is courteously requested.

Inasmuch as the amendment thus overcomes any such objections, rejections and arguments, and further provides the original patent deed as well as a supplemental declaration, it is courteously submitted that upon entry of the amendment and its accompanying documents the present application is in condition for allowance and for reissue of the subject patent.

Accordingly, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. In order to expedite resolution of any remaining issues and further to expedite passage of

the application to issue, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number if any further comments, questions or suggestions arise in connection with the application.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read 'Israel Gopstein', written over the printed name.

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